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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TOBY WEXLER

Appeal 2008-0813
Application 10/824,889
Technology Center 3600

Decided: August 13, 2008

Before WILLIAM F. PATE, III, JOSEPH A. FISCHETTI, and BIBHU R.
MOHANTY, *Administrative Patent Judges*.

FISCHETTI, *Administrative Patent Judge*.

DECISION ON APPEAL
STATEMENT OF THE CASE

Appellant seeks our review under 35 U.S.C. § 134 of the Examiner's final rejection of claims 1-7, 11, 14-17, and 27-39. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

This appeal arises from the Examiner's Final Rejection, mailed January 3, 2006. The Appellant filed an Appeal Brief in support of the appeal on January 16, 2007. An Examiner's Answer to the Appeal Brief was mailed on May 25, 2007. A Reply Brief was filed on June 29, 2007.

SUMMARY OF DECISION

We AFFIRM IN PART.

THE INVENTION

Appellant claims a protective polymeric sheathing for animal toenails which is said to relate more particularly to the manufacture and adaptation of such polymeric sheathings to the animal's nails. (Specification 2:14-16.)

Claim 1, reproduced below, is representative of the subject matter on appeal.

1. An animal toenail covering having an opening at one end and an internal and external shape defining a pliable sheath generally consistent with that of an animal's toenail, said polymeric sheath comprising an external coating of polymer encompassing at least a portion of said polymeric sheath.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Johns	US 2,285,981	Jun. 9, 1942
Field	US 4,908,881	Mar. 20, 1990

The following rejections are before us for review.

1. Claims 1, 2, 5, 27, 28, 30, and 32-35 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Field.
2. Claims 3, 6, 7, and 14-17, 29, 36, and 38-39 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Field.
3. Claims 4, 11, 31, and 37 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Field in view of Johns.

ISSUES

The anticipation issue before us is whether Appellant has shown that the Examiner erred in rejecting claims 1, 2, 5, 27, 28, 30, and 32-35 under 35 U.S.C. § 102(b) as anticipated by Field.

The second issue is whether Appellant has sustained its burden of showing that the Examiner erred in rejecting claims 3, 6, 7, 14-17, 29, 36, and 38-39 on appeal as being unpatentable under 35 U.S.C. § 103(a) over Field.

The third issue is whether Appellant has sustained its burden of showing that the Examiner erred in rejecting claims 4, 11, 31, and 37 on appeal as being unpatentable under 35 U.S.C. § 103(a) over Field in view of Johns.

FINDINGS OF FACT

We find the following facts by a preponderance of the evidence:

1. Field discloses “a sheath-like device adapted to fit over the distal portion of a human finger. Such sheath-like device may be formed of rigid or pliable material such as plastic or cloth fabric. Each sheath-

- like finger guard is shaped to fit slideably over the distal portion of a human finger or thumb. (Field, col. 2, ll. 65-68.)
2. Field discloses that “a false fingernail-shaped insert 48 may be detachably mounted within a recessed notch 50 formed on the upper surface of the sheath 40. Such fingernail-shaped insert 48 may be formed of rigid plastic or similar material and may be prepared in various colors and designs for aesthetic purposes.” (Field, col. 3, ll. 24-28.)
 3. The Merriam-Webster definition of “animal” is: 1: any of a kingdom (Animalia) of living things including many-celled organisms and often many of the single-celled ones (as protozoans) that typically differ from plants in having cells without cellulose walls, in lacking chlorophyll and the capacity for photosynthesis, in requiring more complex food materials (as proteins), in being organized to a greater degree of complexity, and in having the capacity for spontaneous movement and rapid motor responses to stimulation 2 a: one of the lower animals as distinguished from human beings b: mammal; broadly : vertebrate 3: a human being considered chiefly as physical or nonrational; also: this nature 4: a person with a particular interest or aptitude <a political animal>.
(<http://www.merriam-webster.com/dictionary/animal>).
 4. The Merriam-Webster definition of “anticline” is: an arch of stratified rock in which the layers bend downward in opposite directions from the crest — compare syncline (<http://www.merriam-webster.com/dictionary/anticline>).

5. Field discloses "...a fingernail-shaped insert may be detachably affixed to the outer surface of the finger guard, so as to approximate the appearance of a human fingernail. Such detachably connectable fingernail-shaped insert may be prepared in various colors and/or designs for purposes of further enhancing the appearance of the finger guard. (Field, col.1, ll. 53-59.)
6. Field discloses it is well-known for people, primarily women, to synthetically bond artificial fingernails over the top of their natural nails. (Field, col. 1, ll. 8-10.)
7. We understand that such synthetically bonded artificial nails (FF 6) are often colored with a color (e.g., red) different from that of the skin color which surrounds the artificial nail.
8. The Examiner found with respect to the sheathing and coating connection that "...it would have been obvious to one having ordinary skill in the art that such an adhesive element must be present as there is no structural mechanism in which to retain the second polymer layer onto the sheath." (Final Rej. 8.)
9. The Examiner found that "[o]ne of skill in the art would consider the use of a liquid adhesive, a powered adhesive or an aerosol adhesive as a matter of obvious routine choice of design rather than constitute a patentably distinct inventive step barring a convincing showing of evidence to the contrary. (Final Rej. 8.)
10. We understand that the use of adhesive in laminates is generally well known to secure one layer to the next.
11. Johns discloses ribs 7 circumferentially around the wall and as shown in Figures 2 are perpendicular to the surface of the sheath. (Johns,

col. 1, ll. 28-35.)

PRINCIPLES OF LAW

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 827 (1987).

“It is well settled that a prior art reference may anticipate when the claim limitations not expressly found in that reference are nonetheless inherent in it. Under the principles of inherency, if the prior art necessarily functions in accordance with, or includes, the claimed limitations, it anticipates.” *In re Cruciferous Sprout Litig.*, 301 F.3d 1343, 1349 (Fed. Cir. 2002) (citations and internal quotation marks omitted).

“[A] prima facie case of anticipation [may be] based on inherency.” *In re King*, 801 F.2d 1324, 1327 (Fed. Cir. 1986). Once a prima facie case of anticipation has been established, the burden shifts to the Appellant to prove that the prior art product does not necessarily or inherently possess the characteristics of the claimed product. *In re Best*, 562 F.2d 1252, 1255 (CCPA 1977) (“Where, as here, the claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes, the PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product.”) *See also In re Spada*, 911 F.2d 705, 708-09 (Fed. Cir. 1990).

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains.” *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). See also *KSR*, 127 S.Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”)

In *KSR*, the Supreme Court emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” *id.* at 1739, and discussed circumstances in which a patent might be determined to be obvious. In particular, the Supreme Court emphasized that “the principles laid down in *Graham* reaffirmed the ‘functional approach’ of *Hotchkiss*, 11 How. 248.” *KSR*, 127 S.Ct. at 1739 (citing *Graham*, 383 U.S. at 12 (emphasis added)), and reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* The Court explained:

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in

the same way, using the technique is obvious unless its actual application is beyond his or her skill.

Id. at 1740. The operative question in this “functional approach” is thus “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.*

The Supreme Court stated that there are “[t]hree cases decided after *Graham* [that] illustrate the application of this doctrine.” *Id.* at 1739. “In *United States v. Adams*, ... [t]he Court recognized that when a patent claims a structure already known in the prior art that is altered by the mere substitution of one element for another known in the field, the combination must do more than yield a predictable result.” *Id.* at 1739-40. “*Sakraida* and *Anderson’s-Black Rock* are illustrative – a court must ask whether the improvement is more than the predictable use of prior art elements according to their established function.” *Id.* at 1740.

The Supreme Court stated that “[f]ollowing these principles may be more difficult in other cases than it is here because the claimed subject matter may involve more than the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for the improvement.” *Id.* The Court explained:

Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.

Id. at 1740-41. The Court noted that “[t]o facilitate review, this analysis should be made explicit.” *Id.* (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”)). However, “the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.”

ANALYSIS

We affirm the rejection of claims 1, 2, 5, 27, 28, and 30 under 35 U.S.C. § 102(b) as being anticipated by Field and reverse the rejection of claims 32-37 made thereunder.

We affirm the rejection of claims 3, 6, 7, 14-17, 29, and 38-39 under 35 U.S.C. § 103(a) as being unpatentable over Field.

We affirm the rejection of claim 11 under 35 U.S.C. § 103(a) as being unpatentable over Field in view of Johns and reverse the rejection of claims 4 and 31 made thereunder.

Rather than repeat the arguments of Appellants or the Examiner, we make reference to the Brief and the Answer for their respective details. Only those arguments actually made by Appellants have been considered in this opinion. Arguments which Appellants could have made but chose not to make in the Brief have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2007).

Claims 1, 27, 38, and 39 rejected under 35 U.S.C. § 102(b)

Appellant's arguments against each of the rejections of independent claims 1, 27, 38, and 39 are based on perceived deficiencies of Field. Inasmuch as Appellant raises the same issues with respect to each of these claims, we discuss these claims together, addressing each of Appellants' arguments in turn.

Appellant "disputes examiner's contention that the *Field* '881 patent is a proper reference in this case." (Appeal Br. 12.) In support of this position, Appellant cites to the USPTO classification of the Field patent as not being classified with the closest prior art. (*Id.*) We disagree. The classification of a device while being some evidence of "analogy" is far outweighed by the similarities and differences in structure and function of the devices found in the prior art. See *In re Ellis*, 476 F.2d 1370, 1372 (CCPA 1973).

The Appellant argues:

Examiner, repeatedly erroneously describes the *Field* '881 apparatus as having applicant's claimed "internal and external shape generally consistent with that of an animal's toenail" when in fact there is no indication in the *Field* specification that mentions such shape or a drawing that would lead any rational person to that conclusion. In fact *Field* describes his finger covering as 'corresponding to the anatomical shape of a human finger'. A human finger shape is simply not consistent with an animal's toenail.

(Appeal Br. 13-14.)

However, we are not persuaded by Appellant's argument that a human finger shape is simply not consistent with an animal's toenail because the scope of the argument exceeds that of the claims. The claims only require that the covering be pliable generally consistent with that of an animal

toenail. Nothing in the claims require the argued (Appeal Br. 13) triangular shape of a nonhuman nail which, at its proximate end, tapers and curves to a point at it's distal end. Moreover, an animal is defined as any of a kingdom of living things which would include a human (FF 3). Further, the definition of animal identifies a human as one, albeit a higher animal (*Id.*) Thus, Appellant's arguments "fail from the outset because . . . they are not based on limitations appearing in the claims . . .," and are not commensurate with the broader scope of claims 1, 27, 38, and 39 which merely recites that the covering be pliable generally consistent with that of an animal toenail. *In re Self*, 671 F.2d 1344, 1348 (CCPA 1982).

Appellant further contends that the covering 48 over the nail region in Field is not "a second layer of polymer covering at least a portion of the sheath...." (Appeal Br. 14.) We disagree with Appellant. The independent claims only require that an external coating encompass, or overlay the polymeric sheath. The layer 48 in Field is attached to the sheath in Field via a recessed notch 50 (FF 5) so as to overlay or encompass the underlying sheath material.

Appellant next argues that because Field discloses that the sheath can be made of either plastic or cloth fabric, the embodiment where the sheath is made of fabric would not meet requirement of the claims. (Appeal Br. 14.) Although Field does disclose using two such kinds of material to fabricate its sheath, the plastic form of the sheath meets the claim requirements.

Claims 2 and 28, rejection made under 35 U.S.C. § 102(b)

Claims 2 and 28 recite the external coating has a greater hardness than said covering. The Examiner position is that "...the fingernail insert which

is of a thinner structural thickness [than the sheath] and thereby, along with the positive statement that the fingernail insert is a rigid material, it is therefore maintained that Field discloses the second layer of polymer is harder than that of the polymeric sheath.” (Final Rej. 3.) However, Appellant argues that because “Field makes no mention of hardness ... any assumption made regarding hardness of the materials is purely speculation. No comparison can be made without knowing the material specification of each member.” (Appeal Br. 15.) We find that the Examiner has established a prima facie case of anticipation based on inherency based on the explanation established in the record (Final Rej. 3) and that Appellant has failed to prove that the prior art product does not necessarily or inherently possess the characteristics of the claimed product. Accordingly, we sustain the rejection of claims 2 and 28.

Claims 3 and 29, rejection made under 35 U.S.C. § 103(a) using Field

Claims 3 and 29 recite that the sheath and the external coating are different colors. Field discloses that it is known to use artificial nails over the natural nails (FF 6), and we find that the layer 48 may be colored differently. Further, we understand that with artificial nails a person often colors the artificial nail differently from that of the skin which surrounds the nail (FF 7). We conclude that such color difference as between the sheath and the nail overlay is a predictable result of the known practice of nail coloring and the prior art taught by Field. Where, as here “[an application] claims a structure already known in the prior art that is altered by the mere

substitution of one element for another known in the field, the combination must do more than yield a predictable result,” *KSR*, 127 S.Ct. at 1740 (citing *United States v. Adams*, 383 U.S. 50-51 (1966)).

Claims 32-35 rejected under 35 U.S.C. § 102(b)

Claim 32 requires the sheath having a non-uniform wall thickness having a greater thickness at said distal end than at said proximate end. The Examiner interprets the feature in Field as the non-uniform wall thickness where the lamination of layers occurs. We disagree. The sheath in Field has a recess which accounts for the thickness of the superimposed layer 48 so as to effect a contiguous top surface, and hence a uniform thickness. Thus, this region cannot be read as creating a thickness greater at the distal end. We therefore do not affirm the rejection of claim 32 and those claims 33-37 which depend therefrom.

Claim 5 rejection made under 35 U.S.C. § 102(b) using Field

Claim 5 recites a partial delamination between said polymeric sheath and a portion of said external coating of polymer. The Examiner reasoned that since “...Field discloses that the second layer may be removable from the sheath [it] thereby provid[es] the sheath with the delamination between the sheath and the second layer of polymer” (Final Rej. 7.) While we agree with this reasoning, we do not deem it necessary because the limitation goes only to the process by which the layer is created and thus does not add structure to the claim. “If the product in a product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable

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even though the prior product was made by a different process.” *In re Thorpe*, 777 F.2d 695, 697 (Fed. Cir. 1985).

*Claims 6, 7, 14, 15, 16, and 17 rejected under 35 U.S.C. § 103(a) using
Field*

Claims 6, 7, 14, 15, 16, and 17 recite various adhesive forms for attaching the sheath to the external coating. The Examiner found that: 1) "...one having ordinary skill in the art would know that an adhesive element must be present..." (FF 8); and 2) that "[o]ne of skill in the art would consider the use of a liquid adhesive, a powered adhesive or an aerosol adhesive as a matter of obvious routine choice of design rather than constitute a patentably distinct inventive step barring a convincing showing of evidence to the contrary (FF 9). Further, we understand that the use of adhesive in laminates is generally well known to secure one layer to the next (FF 10). Thus we conclude that using an adhesive to attach the sheath to the appendage in Field and to use the various forms thereof as recited in claims 14-17 is a predicable result of the known practice of artificial nail application and the prior art taught by Field. Where, as here "[an application] claims a structure already known in the prior art that is altered by the mere substitution of one element for another known in the field, the combination must do more than yield a predictable result," *KSR*, 127 S.Ct. at 1740 (citing *United States v. Adams*, 383 U.S. 50-51 (1966)).

*Claims 4, 11, 31 and 37 rejected under 35 U.S.C. § 103(a) using
Field and Johns*

Claims 4, 31, and 37 require anticline cleats. We find that the term anticline means that the cleats bend downward in opposite directions from the slope of the sheath inner surface as would be the case if the cleats were arched stratified rock formations (FF 4). In Johns the ribs 7 extend

perpendicularly to the surface of the sheath (FF11) and therefore do meet the requirements of claims 4 and 31. We thus cannot affirm the rejection of claims 4, 31, and 37. However claim 11 only requires that the inner wall be textured. We read the ribs 7 in Johns as constituting a textured surface, and hence they meet the requirement of claim 11. We thus affirm the rejection of claim 11.

CONCLUSIONS OF LAW

We conclude:

1. We affirm the rejection of claims 1, 2, 5, 27, 28, and 30 under 35 U.S.C. § 102(b) as being anticipated by Field and reverse the rejection of claims 32-37.

2. We affirm the rejection of claims 3, 6, 7, 14-17, 29, and 38-39 under 35 U.S.C. § 103(a) as being unpatentable over Field.

3. We affirm the rejection of claim 11 under 35 U.S.C. § 103(a) as being unpatentable over Field in view of Johns and reverse the rejection of claims 4 and 31.

DECISION

The decision of the Examiner to reject claims 1-3,5-7, 11, 14-17, 27-30, 38, and 39 is affirmed.

The decision of the Examiner to reject claims 4, 31-37 is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

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AFFIRMED-IN-PART

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